

ESTTA Tracking number: **ESTTA31510**

Filing date: **04/26/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### **Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

#### **Opposer Information**

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| <b>Name</b>                                  | Everlast World's Boxing Headquarters Corporation     |
| <b>Granted to Date of previous extension</b> | 04/27/2005   |
| <b>Address</b>                               | 1350 Broadway<br>New York, NY 10018<br>UNITED STATES |

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| <b>Attorney information</b> | Jeffrey M. Rollings<br>Lackebach Siegel LLP<br>One Chase Road<br>Scarsdale, NY 10583<br>UNITED STATES<br>tmefs@LSLLP.com, jrollings@LSLLP.com, nsaraco@lsllp.com<br>Phone:914-723-4300 |
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#### **Applicant Information**

|                               |  |                               |            |
|-------------------------------|--|-------------------------------|------------|
| <b>Application No</b>         | 78390923                                   | <b>Publication date</b>       | 12/28/2004 |
| <b>Opposition Filing Date</b> | 04/26/2005                                 | <b>Opposition Period Ends</b> | 04/27/2005 |
| <b>Applicant</b>              | Viacom International Inc.<br>1515 BROADWAY |                               |            |

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| NEW YORK, NY 10036<br>UNITED STATES |
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### **Goods/Services Affected by Opposition**

#### **Class 003.**

All goods and services in the class are opposed, namely: HEALTH AND BEAUTY AIDS, NAMELY, HAIR SHAMPOOS, HAIR GEL, HAIR CONDITIONERS, BUBBLE BATH, SKIN SOAPS, LIQUID SKIN SOAP, COSMETICS, NAMELY, PERFUME AND COLOGNE; TOOTHPASTE, BODY WASH, FRAGRANCES FOR PERSONAL USE; BATH OIL, BODY OIL, MASSAGE OIL, BATH SALTS, BODY LOTION, SKIN LOTION, INCENSE, BODY CREAM, BODY POWDER, SKIN CLEANING CREAM, FACIAL SCRUBS, BATH GEL; MAKEUP, PERSONAL DEODORANTS

#### **Class 016.**

All goods and services in the class are opposed, namely: PRINTED MATTER, NAMELY, NOTE PAPER AND LOOSE LEAF PAPER, SERIES OF FICTION BOOKS, DECALS, BUMPER STICKERS, TRADING CARDS, NOTE CARDS, POSTERS, FOLDERS, CALENDARS, STATIONERY WRITING PAPER AND ENVELOPES, ARTS AND CRAFT PAINT KITS; NOTEBOOKS; BLANK JOURNALS; ADDRESS BOOKS; DIARIES; DAILY PLANNERS; DESKTOP PLANNERS; PERSONAL PLANNERS; BOOKMARKS; AND CARDBOARD; CRAFT BOOKS; SCHOOL SUPPLIES, NAMELY, SCHOOL BOXES MADE OF CARDBOARD, PENCILS, PENS, PEN AND PENCIL CASES AND HOLDERS, ERASERS, PENCIL SHARPENERS, HIGHLIGHTS MARKERS, MARKERS, AND DRAWING RULERS; GIFT WRAPPING PAPER; PAPER PARTY DECORATIONS; PARTY PAPER BAGS

#### **Class 018.**

All goods and services in the class are opposed, namely: UMBRELLAS, LUGGAGE, LUGGAGE TAGS, TOTE BAGS, BACKPACKS, FANNY PACKS, MESSENGER BAGS, HANDBAGS, WALLETS AND PURSES, ATHLETIC BAGS, GARMENT BAGS FOR TRAVEL, KNAPSACKS, CHANGE PURSES, DUFFLE BAGS, BEACH BAGS

#### **Class 025.**

All goods and services in the class are opposed, namely: BATHING SUITS, BATHROBES, BEACHWEAR, CLOTHING BELTS, SHORTS, JACKETS, COATS, SOCKS, FOOTWEAR, BANDANAS, SWEATERS, HALLOWEEN COSTUMES, DRESSES, GLOVES, GYM SHORTS, EAR MUFFS, NECKWEAR, PAJAMAS, PANTS, SHIRTS, SWEAT SHIRTS, SKI WEAR, SLACKS, SUN VISORS, SUSPENDERS, TURTLENECKS, UNDERCLOTHES, VESTS, WARM-UP SUITS, HEADWEAR

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| <b>Attachments</b> | Notice of Opposition 4 26 05 Scan.doc.pdf ( 9 pages ) |
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|                  |                       |
|------------------|-----------------------|
| <b>Signature</b> | /Jeffrey M. Rollings/ |
| <b>Name</b>      | Jeffrey M. Rollings   |
| <b>Date</b>      | 04/26/2005            |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Application Serial No.:** 78/390923  
**Mark:** EVERCHAMP  
**International Class:** 3, 16, 18, 25  
**Applicant:** Viacom International Inc.  
**Date of Publication:** December 28, 2004

|                            |   |                |
|----------------------------|---|----------------|
| -----                      | X |                |
| EVERLAST WORLD'S BOXING    | : |                |
| HEADQUARTERS CORP.,        | : |                |
|                            | : |                |
| Opposer,                   | : | Opposition No. |
|                            | : |                |
| v.                         | : |                |
|                            | : |                |
| VIACOM INTERNATIONAL INC., | : |                |
|                            | : |                |
| Applicant.                 | : |                |
| -----                      | X |                |

**NOTICE OF OPPOSITION**

EVERLAST WORLD'S BOXING HEADQUARTERS CORPORATION ("Opposer"), a corporation organized and existing under the laws of the state of New York, with offices in New York, New York, believes that it will be damaged by the registration of the trademark EVERCHAMP by VIACOM INTERNATIONAL, INC. ("Applicant") as applied for in Application Serial Number 78/390923 (the "Application"), for use in connection with health and beauty products, clothing and accessories, printed matter, and luggage in International Classes 3, 25, 16, and 18, respectively.

As grounds for opposition it is alleged that:

1. Opposer is a corporation organized and existing under the laws of the state of New York, with offices in New York, New York.
2. Opposer manufactures, promotes, distributes, and sells a wide variety products, and licenses others to manufacture, promote, distribute, and sell products, utilizing a family of “EVERLAST” trademarks, including primary and house mark EVERLAST as a designation of the source of Opposer’s goods.
3. Opposer is the owner of the trademark EVERLAST (including various stylizations thereof) (“Opposer’s Trademark”) for use in connection with a wide variety of goods, including without limitation: boxing gloves; punching bags; medicine balls; boxing rings; exercise mats; jump ropes; martial arts and punch mitts; bicycle exercisers; rowing machines; chinning bars; dumbbells; ankle and wrist weights; weight-lifting belts; exercise hand grips and power grips; sit-up bars; push-up bars; sports mouth pieces; adhesive tape for boxing; sports head guards; men’s, women’s and children’s clothing; eye wear; batteries; luggage, soft drinks; watches; nutritional supplements; and personal body care products.
4. Opposer has used Opposer’s Trademarks in interstate commerce since approximately 1912.
5. As part of its normal business operations, Opposer actively seeks to expand its usage of Opposer’s Trademarks and seeks new and additional licensees for its Trademarks.
6. Without limitation, Opposer is the owner of the following United States Trademark Registrations and Applications for Registration in connection with Opposer’s Trademarks:

- a. Registration No. 524,970, for the mark EVERLAST (stylized) in International Class 28, registered on May 9, 1950, in connection with, *inter alia*, boxing gloves, striking bags, and dumbbells;
- b. Registration No. 803,366, for the mark EVERLAST in International Class 28, registered on February 8, 1966, in connection with, *inter alia*, punching bags, wrestling and boxing trunks and shirts;
- c. Registration No. 855,036, for the mark EVERLAST (stylized) in International Classes 25 and 28, registered on the Principal Register on August 20, 1968, in connection with, *inter alia*, medicine balls, punching bags, and boxing and wrestling trunks and shorts;
- d. Registration No. 1,291,250, for the mark EVERLAST in International Class 25, registered on the Principal Register on August 21, 1984, in connection with clothing, namely shoes, shirts, trunks, warm-up suits and robes;
- e. Registration No. 1,346,377, for the mark EVERLAST (stylized) in International Class 25, registered on the Principal Register on July 2, 1985, in connection with clothing, namely, shoes, shirts, trunks, warm-up suits, and robes;
- f. Registration No. 1,429,227, for the mark EVERLAST in International Class 18, registered on the Principal Register on February 17, 1987, in connection with luggage;
- g. Registration No. 1,437,396, for the mark EVERLAST and Design in International Class 27, registered on the Principal Register on April 21,

1987, in connection with sports and athletic equipment, namely wrestling mats;

- h. Registration No. 1,769,437, for the mark EVERLAST (stylized) in International Class 32, registered on the Principal Register on May 4, 1993, in connection with soft drinks;
- i. Registration No. 1,769,438, for the mark EVERLAST in International Class 32, registered on the Principal Register on May 4, 1993, in connection with soft drinks;
- j. Registration No. 1,864,807, for the mark EVERLAST (stylized) in International Class 28, registered on the Principal Register on November 29, 1994, in connection with, *inter alia*, boxing gloves, dumbbells, skip ropes, boxing and wrestling trunks and shorts, equipment bags, and gym bags;
- k. Registration No. 1,898,922, for the mark EVERLAST (stylized) in International Classes 18 and 25, registered on the Principal Register on June 13, 1995, in connection with, *inter alia*, back packs, luggage, and tote bags, and clothing, namely, pants robes, shirts, shorts sleepwear, underwear, exercise suits, muscle shirts, sweatpants, sweatshirts, swimwear, and t-shirts;
- l. Registration No. 1,962,202, for the mark EVERLAST in International Class 14, registered on the Principal Register on May 12, 1996, in connection with, *inter alia*, watches, clocks, and stopwatches.

- m. Registration No. 2,171,626, for the mark EVERLAST (stylized) in International Class 5, registered on the Principal Register on July 7, 1997, in connection with nutritional supplements;
- n. Registration No. 2,158,328, for the Mark EVERLAST and Design in International Classes 9, 18, 25, and 28, registered on the Principal Register on February 24, 1998, for use in connection with, *inter alia*, protective helmets, equipment and gym bags, clothing, and boxing and exercise equipment;
- o. Registration No. 2,315,855, for the mark EVERLAST WOMAN (stylized) in International Class 25, registered on the Principal Register on November 16, 1999, for use in connection with woman's clothing;
- p. Registration No. 2,701,246, for the mark EVERLAST in International Class 9, registered on the Principal Register on March 25, 2003, for use in connection with eyewear;
- q. Registration No. 2,881,907, for the mark EVERLAST in International Class 9, registered on the Principal Register on September 7, 2004, for use in connection with batteries;
- r. Registration No. 2,869,963 for the mark EVERLAST (stylized) in International Class 3, registered on the Principal Register on August 3, 2004, for use in connection with men's personal body care products;
- s. Application Serial No. 78/244,916, for the mark EVERLAST (stylized) in International Class 32, filed on May 2, 2003, and allowed for registration



- pursuant to Everlast's Statement of Use by the examiner on March 30, 2005, in connection with soft drinks;
- t. Application Serial No. 78/244,904, for the mark EVERLAST in International Class 32, filed on May 2, 2003, and allowed for registration pursuant to Everlast's Statement of Use by the examiner on March 30, 2005, in connection with soft drinks;
  - u. Application Serial No. 78/197,447, for the mark EVERLAST in International Class 11, filed on December 23, 2002, in connection with flashlights, lamps, electric lighting fixtures, pen lights, electric night lights, lampshades, and electric track lighting units;
  - v. Registration No. 2,867,444 for the mark EVERLAST in International Class 3, registered on the Principal Register on July 27, 2004, for use in connection with personal care products;
  - w. Application Serial No. 76/393,806, for the mark EVERLAST in International Class 9, filed on April 9, 2002, for which a Notice of Allowance was mailed on February 4, 2003, in connection with computer and video game cartridges, computer game software, programs and tapes; and
  - x. Application Serial No. 78/382,959, for the mark EVERLAST in International Class 10, filed on March 12, 2004, for which a Notice of Allowance was mailed on April 26, 2005, in connection with condoms.
7. Without limitation, Opposer's Registrations and Applications cover International Classes 3, 5, 9, 10, 11, 14, 18, 25, 27, 28, and 32.

8. Through the years, Opposer has expended substantial amounts of money, time and effort in advertising, promoting and popularizing Opposer's Trademarks; the trade, industry, and public have throughout the years, associated and attributed usage of Opposer's Trademarks to Opposer and Opposer alone, so that the trade in general and the purchasing public in particular have come to know and recognize Opposer's Trademarks and products and to know that the same originate with and belong to Opposer.
9. Opposer has used Opposer's Trademarks in interstate commerce openly, notoriously and continuously since the dates of first use of Opposer's Trademarks.
10. Opposer's Trademarks are strong trademarks and are famous throughout the United States and the world and have developed goodwill and a good reputation exclusive to Opposer.
11. Upon information and belief, Applicant is a Delaware corporation, with an address at 1515 Broadway, New York, NY 10036.
12. The purported "EVERCHAMP" mark applied for in Applicant's application is confusingly and deceptively similar to Opposer's Trademarks, which Opposer has been using long prior to the filing of Applicant's intent to use application; hence, Applicant is not entitled to adopt, use, or seek registration of the purported "EVERCHAMP" mark in connection with the goods identified in Applicant's application.
13. The goods identified in Applicant's application are identical, nearly identical, and/or closely related to Opposer's Goods sold under Opposer's Mark, and/or to

- goods likely to be distributed and sold by Opposer, allowing for Opposer's normal and foreseeable expansion of use and licensing of Opposer's Trademarks.
14. The goods covered by Applicant's application are of the type distributed and sold by Opposer, through the same channels of trade and to the same class of customers as Opposer's goods, and/or likely to be distributed and sold by Opposer, through the same channels of trade and to the same class of purchasers as Opposer's goods, allowing for Opposer's normal and foreseeable expansion of use and licensing of Opposer's Trademarks. Such goods would reasonably be expected by the trade and purchasing public to emanate from or be sponsored by the same source.
  15. Opposer's Mark and Applicant's purported mark are so similar in appearance, connotation and pronunciation, that contemporaneous use of the respective marks will create a likelihood of confusion, mistake or deception among the trade and consumers.
  16. Because of the strength and fame of Opposer's Mark and because Applicant's purported mark is confusingly similar thereto, any faults or imperfections in the goods of Applicant will reflect adversely on Opposer and its established goodwill and reputation, all to the detriment of Opposer unless this opposition is sustained.
  17. The simultaneous use and/or registration by Applicant of the mark EVERCHAMP will dilute and tarnish Opposer's rights and will eventually result in a lack of designation or indication of origin and a loss of distinctiveness and exclusivity in Opposer's Mark if Applicant is allowed to register its purported mark.

18. Opposer clearly has superior and paramount rights as compared to Applicant and Opposer has used Opposer's Trademarks in commerce continuously, since 1912, a date prior to any date claimed by or available to Applicant. Consequently, Opposer avers that confusion, mistake, deception, dilution and tarnishment in the trade and in the minds of the purchasers as between Opposer's and Applicant's marks and as to the origin of their respective goods will be likely and bound to occur with resulting damage to Opposer.

**WHEREFORE**, Opposer respectfully requests that the Opposition be sustained and that registration of EVERCHAMP to Applicant be refused.

This Notice of Opposition is being filed in duplicate, as required by 37 C.F.R. § 2.104, along with the \$300.00 fee required by 37 C.F.R. §§ 2.101 and 2.6 for each class opposed for a total of \$1,200.00.

Respectfully submitted,

**LACKENBACH SIEGEL, LLP**

Dated: Westchester, New York  
April 26, 2005

By: 

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